



JCO5 Rec'd PCT/PTO 21 SEP 2001
09-24-01/09/831631 PCT
Express Mail No.: EL 501 641 619 US

PATENT

Box 568-

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: R. M. Burch et al.

Group Art Unit: To be assigned.

Serial No.: 09/831,631

Examiner: To be assigned.

Filed: National Stage of PCT Application

Attorney Docket No.: 6750-0018-999

PCT/US99/26671 filed November 12,
1999

For: CONTRACEPTIVE ANTIBODY
VACCINES

**RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS
UNDER 35 U.S.C. 371 IN THE DO/EO/US**

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Notification of Missing Requirements under 35 U.S.C. 371 in the DO/EO/US ("Notification") dated June 21, 2001, submitted herewith are the Declaration for Non-Provisional Patent Application executed by R. M. Burch on August 18, 2001 and D. Sackler on August 14, 2001, a Sequence Listing in paper and computer-readable format pursuant to 37 C.F.R. § 1.821(c) and (e), and the Preliminary Amendment under 37 C.F.R. § 1.115, for the patent application, 09/831,631 (filed May 10, 2001), which is the U.S. national stage patent application of the PCT International Application No. PCT/US99/26671 filed on November 12, 1999, claiming the benefit under 35 U.S.C. § 119(e) of U.S. provisional application no. 60/108,325 filed November 13, 1998.

Surcharge of \$130.00 for furnishing the declaration later than 30 months from the earliest claimed priority date was paid at the filing of the subject application on May 10, 2001. A copy of the Notification is attached hereto. Applicants submit concurrently herewith a Petition for Extension of Time for one (1) month accompanied by the fee. Please charge all required fees to Pennie & Edmonds Deposit Account No. 16-1150. A copy of this sheet is enclosed.

Respectfully submitted,

Date: September 21, 2001

Adriane M. Antler 32,605
Adriane M. Antler (Reg. No.)

PENNIE & EDMONDS
1155 Avenue of the Americas
New York, New York 10036-2711
(212) 790-9090

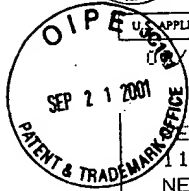
Enclosures

by Margaret B. Bivandian
Reg. No. 40,922
NY2 - 1232988.1



UNITED STATES PATENT AND TRADEMARK OFFICE

09/831631

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/831,631	BURCH	R 6750-018

ENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036-2711

5611

INTERNATIONAL APPLICATION NO.

PCT/US99/26671

I.A. FILING DATE

PRIORITY DATE

11/12/99

11/13/98

06/21/01

DATE MAILED:

**NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE
DISCLOSURES**

Applicant has submitted papers under 35 U.S.C. 371 to enter the national stage in the United States of America. The items indicated below, however, are missing. The period within which to correct the deficiency noted below and avoid abandonment is set forth in the accompanying Notification.

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

- ☒ The application fails to comply with the requirements of 37 CFR 1.821-1.825.
- ☐ This application does not contain, a "Sequence Listing" as a separate part of the disclosure on paper copy or compact disc, as required by 37 CFR 1.821(c).
- ☐ A copy of the "Sequence Listing" in computer readable format has not been submitted as required by 37 CFR 1.821(e).
- ☐ A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
- ☐ The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ The paper copy or compact disc of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- ☐ Other: _____

APPLICANT MUST PROVIDE:

- ☐ An initial or substitute computer readable form (CRF) of the "Sequence Listing."
- ☒ An initial or substitute paper copy or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.
- ☐ A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

FOR QUESTIONS REGARDING COMPLIANCE WITH THESE REQUIREMENTS, PLEASE
CALL:

(703) 308-4216, for Rules interpretation,
(703) 308-4212, for CRF submission help,
(703) 287-0200, for Patent software help.

Kaya D. Moore

National Stage Process

(703) 305-3695

Telephone:



UNITED STATES PATENT AND TRADEMARK OFFICE

09/831631

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
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U.S. APPLICATION NO.

FIRST NAMED APPLICANT

ATTY. DOCKET NO.

09/831,631

BURCH

5611

R 6750-018
INTERNATIONAL APPLICATION NO.

PCT/US99/26671

I.A. FILING DATE

PRIORITY DATE

11/12/99

11/13/98

DATE MAILED: 06/21/01

NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371(c)(4) for entry into the national stage in the United States of America. The period within which to correct the deficiency noted below and avoid abandonment is set in the accompanying Notification.

A new oath or declaration, properly identifying this application (preferably by the international application number and international filing date) is required. The oath or declaration does not comply with 37 CFR 1.497(a),(b) and (f) in that it:

1. ☒ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2. ☐ does not identify the application to which it is directed.
3. ☐ does not identify the inventor(s).
4. ☐ does not identify the citizenship of each inventor.
5. ☐ does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b), AND 1.497(d) WHERE APPROPRIATE, WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the mailing address of each inventor. If the residence is different from the mailing address, then the city and state or city and foreign country of residence of each inventor must also be given.
2. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate for which a claim for priority is made pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.

Key-Batch 09

National Stage Process

(753) 305-3695

Telephone:



UNITED STATES PATENT AND TRADEMARK OFFICE

09/831631

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United States Patent and Trademark Office
Washington, D.C. 20231
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U.S. APPLICATION NO. 09/831,631 FIRST NAMED APPLICANT BURCH ATTY. DOCKET NO. 6758-013

INTERNATIONAL APPLICATION NO.
PCT/US99/26671

I.A. FILING DATE 11/12/99 PRIORITY DATE 11/13/98

DATE MAILED: 06/21/01

PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036-2711

Oath/Decl Due 8/21/01

Sequence Listing Due 8/21/01

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):
- ☒ U.S. Basic National Fee. ☐ Indication of Small Entity Status.
 - ☒ Copy of the international application. ☐ Translation of the international application into English.
 - ☐ Oath or Declaration of inventors(s). ☐ Translation of Article 19 amendments into English.
 - ☐ Copy of Article 19 amendments. ☐ Other:
 - ☐ Priority Document.
 - ☒ The International Preliminary Examination Report in English and its Annexes, if any.
 - ☐ Translation of Annexes to the International Preliminary Examination Report into English.
2. ☒ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.
- ☐ U.S. Basic National Fee.
 - ☐ Copy of the international application.
3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:
- ☐ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
 - ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
 - ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
 - ☐ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
 - ☒ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
 - ☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)). ** Surcharge is paid **
4. Additional claim fees of \$ _____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.
5. ☒ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.
7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation
☐ PTO-875 ☒ PCT/DO/EO/920

FORM PCT/DO/EO/905 (March 2001)

Telephone:

Key-Patent
National Stage Process
(733) 308-3695
1072

